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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 01/21/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-19

# Office Action Summary

Application No.

09/332,420

Applicant(s)

HAUBER, DAVID EDGAR

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

## RESPONSE TO AMENDMENT

### *Request for Continued Examination*

1. The request for a continued prosecution application (CPA) under 37 CFR 1.53(d) filed on October 22, 2002 is acknowledged. 37 CFR 1.53(d)(1) was amended to provide that the prior application of a CPA must be: (1) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, (2) a design application, or (3) the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000. *See Changes to Application Examination and Provisional Application Practice*, interim rule, 65 *Fed. Reg.* 14865, 14872 (Mar. 20, 2000), 1233 *Off. Gaz. Pat. Office* 47, 52 (Apr. 11, 2000). Since a CPA of this application is not permitted under 37 CFR 1.53(d)(1), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR 1.114. *See id.* at 14866, 1233 *Off. Gaz. Pat. Office* at 48. Since Applicant has already filed a CPA on January 17, 2002, which is after May 29, 2000, CPA practice no longer applies and the request was treated as a request for an RCE. *See* MPEP § 706.07 (h).
2. The request filed on October 22, 2002 for a request for continued examination (RCE) under 37 CFR 1.114 is acceptable and an RCE has been established. An action on the RCE follows.

***WITHDRAWN REJECTIONS***

3. The 35 U.S.C. §102/§103 rejection of claims 1-6 as anticipated or over Gibson et al. (H1261) of record in paper #12, pages 2-4, paragraph #4 have been withdrawn due to Applicant's amendment in paper #18.

4. The 35 U.S.C. §103 rejection of claims 7-10 over Gibson et al. (H1261) of record in paper #12, page 4, paragraph #5 have been withdrawn due to Applicant's amendment in paper #18.

***NEW REJECTIONS***

5. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 112***

6. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claims 1 and 7 now recite the limitations "the subsequent thermal bonding of applied fibers ***only*** adhering the applied fibers to the outer wall surface of the underlying pipe length without utilizing further adherence agents" and "while ***not*** further melting said underlying pipe length to avoid introducing thermally induced residual stress therein." The specification does not disclose that the fibers are solely adhered to the outer

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wall surface, just that they are primarily adhered to the outer wall surface, nor that the underlying pipe is not further melted.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

### ***Claim Rejections - 35 USC § 102***

7. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Gibson et al. (H1261).

Gibson discloses filament wound parts or structures for containers such as tanks, pressure vessels, cylinders and bottles, and conduits such as piping and tubing, which may be used for pressurized or compressed gases and cryogenic gases (col. 1, lines 11-15). The filament wound composite comprising a melt-processable thermoplastic matrix (thermoplastic organic member) with reinforcing or structural wound fibers (col. 2, lines 37-41). The reinforcing fibers are high strength, non-thermoplastic, reinforcing or structural fibers may be glass such as E glass and S glass, aramid, carbon, and boron (col. 3, lines 17-20).

Example 1 discloses that the thermoplastic matrix is formed around a cylindrical mandrel and then solidified. Reinforcing fibers are then wound around the cylindrical thermoplastic matrix in multiple layers at a wind angle or 65° or the hoop direction. After each layer is of reinforcing fibers is wound around the thermoplastic matrix hot air is direct onto the filament at

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the point of mandrel contact so that the thermoplastic material is in a thixotropic molten state, and the hand-held press roll is used to apply a pressure of about ten pounds at the impingement point.

The filament wound composite is formed of a structural fiber and a melt-processable, thermoplastic fiber commingled into a tow, is wound onto a mandrel to form a multi-ply composite. During the filament winding thermoplastic material wound onto the mandrel, is heated to a thixotropic molten state. (Thermal bonding of the applied fibers only adhering the applied fibers to the outer wall surface of the underlying pipe length without utilizing further adherence agents.) Beneficially, to provide uniformity of melting of the thermoplastic material and avoid thermally induced strain in the consolidated structure (avoiding introducing thermally induced residual stress therein), heat is applied to an internal surface of the wound filament, and is applied to an internal surface of the wound filament, and is applied from a second heat source to an external surface of the wound filament. See column 3, lines 41-52.

The phrase “for maximum effectiveness in withstanding the applied internal stress when the reinforced pipe length is subsequently put into service” is an intended use. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations.

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably

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conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations the continuous fibers having been continuously applied in an unbonded condition and while not further melting said underlying pipe length are methods of production and therefore does not determine the patentability of the product itself.

### ***Claim Rejections - 35 USC § 103***

8. Claims 7-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al. (H1261).

Gibson discloses all the limitation of the instant claimed invention except for the a plurality of reinforced pipe lengths joined together at the ends. It would have been obvious to one of ordinary skill in the art at the time of the invention to make short pipes to be connected end to end later for easy storage and transportation of the pipe before use.

***ANSWERS TO APPLICANT'S ARGUMENTS***

9. Applicant's arguments filed in paper #18 regarding the Gibson (H1261) reference have been carefully considered but are deemed unpersuasive.

Applicant argues that the requirement in Gibson et al to heat the underlying pipe to a "molten state" produces thermally induced residual stress in the final article which is a serious impediment far less encountered in the now claimed improvement.

Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. MPEP § 2145

Furthermore, Gibson also wants to reduce thermally induced residual stress, see Gibson col. 3, lines 39-53. It remains the examiner's position that the filament wound composite of Gibson is identical to or only slightly different than the claimed fiber reinforced pipe prepared by the method of the claims, because both articles have the same thermoplastic wall material and the same fiber material. The burden is on the applicant to provide evidence that the process in the instant claims provides a far superior product.

Applicant argues that Gibson's thermal expansion mismatch between the fiber and the underlying pipe becomes very *likely* to produce a physical separation there between during reheating. Applicant's argument/conjecture is not evidence.

Applicant argues that the thermoplastic member in Gibson is said to require a thermoplastic material selection which is both "melt-processable" and "shear sensitive" and that



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a PEEK polymer would not be a suitable thermoplastic material and that the now claimed final product is not limited in the same regard. While applicant's material may not be limited to any specific material besides a thermoplastic organic, the claim language does not exclude the materials used in Gibson. The fact the applicant's claimed invention can use more material than represented in Gibson does not change the fact that Gibson anticipates this limitation.

Applicant's further arguments are merely speculations that Gibson does not possess these improved properties gained by the process for making the instant claimed invention. Since it remains the examiner's position that the filament wound composite of Gibson is identical to or only slightly different than the claimed fiber reinforced pipe prepared by the method of the claims, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art.

### ***Conclusion***


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

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HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
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